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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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46334 7590 02/22/2008 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202				
EXAMINER CUMBERLEDGE, JERRY L				
ART UNIT		PAPER NUMBER		
3733				
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02/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,638

Applicant(s)

SHORES ET AL.

Examiner

JERRY CUMBERLEDGE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 0207.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 22-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 and 22-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-13, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mickel et al. (US Pat. 6,062,575).

Mickel et al. disclose a coupling system, for a medical dissection tool, the coupling system configured to interconnect with a power source to a dissection tool, the coupling system comprising: a coupling shaft (Fig. 1A, ref. 60) having a proximal portion for receiving power from the power source (column 5, lines 52-58), a distal portion and a longitudinal axis, said distal portion having an external surface and defining an internal passage (Fig. 1A, surrounding ref. 54) adapted for receiving a portion of the medical dissection tool (Fig. 1A, ref. 50), and at least one aperture (Fig. 1A, ref. 80) extending from said external surface to said internal passage; and at least one locking member (Fig. 1A, ref. 82) positioned adjacent said at least one aperture and movable with respect to the coupling shaft through a first path in a direction at least partially parallel to said longitudinal axis into a locked position to prevent the medical dissection tool from moving along the longitudinal axis of the internal passage (column 7, lines 17-25). The first path is created by moving the at least one locking member toward the tool shaft and in a direction parallel to the longitudinal axis. The ball will roll longitudinally with respect

to the tool and move into the aperture (Fig. 1A and Fig 1B). The first path extends at an angle of approximately 45° to the longitudinal axis. The first path will extend at an angle of about 45 degrees, since the engagement sleeve (Fig. 1B, ref. 71) has an internal contact surface (Fig 1B, ref. 72) which is angled at about 45 degrees (Fig. 1B, ref. 72). The at least one locking member comprises a spherical ball (Fig. 1A, ref. 82). The at least one locking member comprises three locking members (column 6, lines 19-26). The at least one locking member comprises three spherical balls (column 6, lines 19-26). The proximal portion and said distal portion are integrally formed on a single shaft (Fig. 1A) (column 5, lines 58-63). The coupling system further comprises an engagement sleeve (Fig. 1B, ref. 71) disposed adjacent said distal portion, said engagement sleeve having an internal contact surface (Fig 1B, ref. 72) configured for engaging the at least one locking member into a locked position through the first path. The dissection tool includes a proximal end (Fig. 1A, ref. 50) and said internal passage includes an internal shoulder (Fig. 1A, ref. 64), said at least one locking member in said locked position urging said dissection tool proximal end against said internal shoulder. The system further includes a biasing member (Fig. 1A, ref. 40) urging said engagement sleeve to contact said at least one locking member to move to said locked position. The at least one locking member moves through a second path into an unlocked position. The system further comprises an engagement shaft (Fig. 1a, ref. 52) wherein at least one opening (the openings near ref. 52, Fig. 1B) in the engagement shaft holds the at least one locking member (Fig. 1B). The coupling system of claim 1 further comprises a retention member (Fig. 1B, ref. 54) residing inside the internal

passage wherein the retention member is configured to couple with one end of the medical dissection tool (Fig 1B).

Mickel et al. further disclose a coupler for coupling a power source to a surgical dissection tool having a longitudinal axis, the coupler comprising: a housing (Fig. 1A, ref. 65) defining an outer surface with a portion adapted for coupling to the power source (column 5, lines 52-58) and an internal passage (Fig. 1A, surrounding ref. 54), the aperture at least partially defined by a proximal surface portion and an opposing surface portion for receiving a portion of the dissection tool, an aperture (Fig. 1A, ref. 80) defined between said outer surface and said internal passage; and at least one locking member (Fig. 1a, ref 82) disposed adjacent said aperture, said locking member moveable at least partially along the longitudinal axis from an, unlocked position disposed substantially outside said internal passage (Fig. 1A) and spaced from the proximal surface portion to a locked position spaced from the distal surface portion and having at least a portion of said locking member disposed within said internal passage (Fig.1B); and an engagement member (Fig. 1B, ref. 71) disposed adjacent said aperture for urging the locking member into the locked position through a first path. The portion near ref. 54 in Fig. 1A can be considered to be the proximal surface portion of the internal passage and the portion to the left of ref. 52 in Fig. 1A (where the shaft 50 is shown residing) can be considered to be the distal surface portion of the internal aperture. The portion of the internal passage where the locking mechanism is located when the device is locked (as shown in Fig. 1B) can be defined as being part of the proximal surface portion. When the device is unlocked (Fig. 1A), the locking mechanism

is not within the internal passage and is spaced from both the distal and the proximal portions, and when the device is locked it still remains spaced from the distal surface portion. The first path includes movement of the locking member toward the dissection tool and movement parallel to the longitudinal axis. The ball will roll longitudinally with respect to the tool and move down towards the tool (Fig. 1A and 1B). The first path is at approximately 45° to the longitudinal axis. The first path will extend at an angle of about 45 degrees, since the engagement sleeve (Fig. 1B, ref. 71) has an internal contact surface (Fig 1B, ref. 72) which is angled at about 45 degrees (Fig. 1B, ref. 72). The locking member comprises a spherical ball (Fig. 1A, ref. 82). The coupling assembly comprises two additional locking members (column 6, lines 19-26). The three locking members comprise three spherical balls (column 6, lines 19-26). The locking member moves through another path into an unlocked position. The path would be reversed in the unlocking step. The coupler further comprises an engagement shaft (Fig. 1a, ref. 52) wherein an opening (the opening near ref. 52, Fig. 1B) in the engagement shaft holds the locking member.

A coupling assembly joining a power source to a medical dissection tool having a longitudinal axis, the coupling assembly comprising: a coupling housing (Fig. 1A, ref. 65) having a proximal portion configured to receive power from the power source (column 5, lines 52-58) and a distal portion configured to receive a portion of the dissection tool (Fig. 1A, surrounding ref. 54); and a means for locking the dissection tool to the coupling housing configured to move the dissection tool within the coupling housing along the longitudinal axis, wherein said means for locking is at least partially

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moveable along the longitudinal axis with respect to the coupling housing (Fig. 1A and 1B). The means include the balls (Fig. 1A, ref. 82), the engagement sleeve (Fig. 1B, ref. 71), the biasing member (Fig. 1A, ref. 40), and the shaft (Fig. 1a, ref. 52) with openings (the openings near ref. 52, Fig. 1B). The coupling housing includes an internal bore (Fig. 1A, surrounding ref. 54) configured to receive the dissection tool, and the internal bore includes an internal shoulder (Fig. 1A, ref. 64), said means for locking configured to move the dissection tool into an abutting engagement with said internal shoulder in a locked position (Fig. 1A and Fig. 1B).

With regard to the statements of intended use and other functional statements (e.g. ...configured for engaging...), they do not impose any structural limitations on the claims distinguishable over the coupling system of Mickel et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

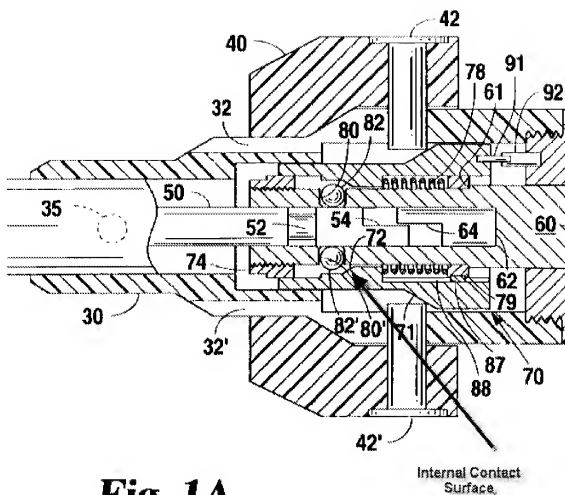


Fig. 1A

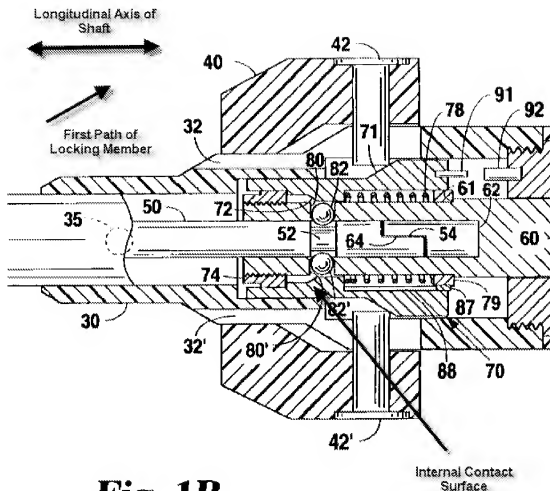


Fig. 1B

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 24-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Mickel et al. (US Pat. 6,062,575) in view of Crawford (US Pat. 4,060,219).

Mickel et al. discloses a coupling system for connecting a power source to a medical dissection tool (Fig. 1A), the coupling system comprising: a coupling shaft (Fig. 1A, ref. 60) having a proximal portion, an opposing distal portion, and a longitudinal axis extending therebetween (Fig. 1), wherein a section of the distal portion comprises an external surface and an internal surface (Fig. 1), the internal surface defining an internal passage (Fig. 1A, surrounding ref. 54) for receiving a portion of the medical dissection tool, the coupling shaft further comprising a first aperture (Fig. 1A, ref. 80) extending from the external surface to the internal surface (Fig. 1A); and a first locking member (Fig. 1A, ref. 82) positioned at least partially within the first aperture (Fig. 1A) and movable along the longitudinal axis with respect to the coupling shaft from an unlocked position to a locked position to secure the medical dissection tool within the internal passage (Fig. 1A). The first aperture defines a proximal wall portion and a distal wall portion separated by substantially the length of the aperture along the longitudinal axis (Fig. 1A, walls on either side of locking member), the first locking member being spaced from the proximal wall portion in the unlocked position and spaced from the distal wall portion in the locked position (Fig. 1A). The first locking member is positioned adjacent to the distal wall portion in the unlocked position and adjacent to the proximal wall portion in the locked position (Fig. 1A). The first locking member comprises a spherical ball (Fig. 1A, ref. 82). The coupling shaft further comprises: a second aperture (column 6, lines 19-26) extending from the external surface to the internal surface, the second

aperture having a second length extending substantially along the longitudinal axis and a second width extending substantially transverse to the longitudinal axis, the second length being greater than the second width such that the second aperture is elongated along the longitudinal axis; a third aperture (column 6, lines 19-26) extending from the external surface to the internal surface, the third aperture having a third length extending substantially along the longitudinal axis and a third width extending substantially transverse to the longitudinal axis, the third length being greater than the third width such that the third aperture is elongated along the longitudinal axis; wherein the first, second, and third apertures are equally spaced about a circumference of the coupling shaft (column 6, lines 19-26, e.g. "evenly"). A second locking member (column 6, lines 19-26) positioned at least partially within the second aperture and movable along the longitudinal axis with respect to the coupling shaft from an unlocked positioned to a locked position to secure the medical dissection tool within the internal passage; and a third locking member (column 6, lines 19-26) positioned at least partially within the third aperture and movable along the longitudinal axis with respect to the coupling shaft from an unlocked positioned to a locked position to secure the medical dissection tool within the internal passage; wherein the first, second, and third locking members comprise spherical balls (Fig. 1A). The coupling system further comprises an engagement sleeve (Fig. 1B, ref. 71) movably engaged with the coupling shaft, the engagement sleeve having a tapered internal contact surface (Fig 1B, ref. 72) for moving the first locking member along the longitudinal axis with respect to the coupling shaft from the unlocked positioned to the locked position. The first locking

member is moveable at approximately a 45° angle relative to the longitudinal axis from the unlocked position to the locked position (Fig. 1A, 1B).

Mickel et al. disclose the claimed invention except for the first aperture having a first length extending substantially along the longitudinal axis and a first width extending substantially transverse to the longitudinal axis, the first length being greater than the first width such that the first aperture is elongated along the longitudinal axis. Mickel et al. disclose that the locking member and the apertures are use to couple two devices (abstract).

Crawford disclose a coupling device (Fig. 1) that comprises a locking member (Fig. 1, ref. 144) and an aperture (Fig. 1, near ref. 144) having a first length extending substantially transverse to the longitudinal axis (Fig. 1)(Fig. 7, near ref. 146), the first length being greater than the first width (Fig. 1) (Fig. 7 near ref. 146) such that first aperture is elongated along the longitudinal axis (Fig. 1) (Fig. 7 near ref. 146). Crawford discloses that this mechanism is used to couple two devices (abstract)(column 4, lines 1-53).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have substituted the locking members and apertures of Mickel et al. with the locking member and aperture of Crawford, in order to achieve the predictable result of coupling two devices.

Response to Arguments

Applicant's arguments filed 11/21/2007 have been fully considered but they are not persuasive.

With regard to Applicant's argument that the locking members are not movable with respect to the coupling shaft through a first path in a direction at least partially parallel to the longitudinal axis, the examiner respectfully disagrees. Initially, the locking member (the ball) spins, hence it moves, and at least a component of the rotational motion would be along a first path in a direction at least partially parallel to the longitudinal axis. Secondly, the ball is not fixed within the space provided (e.g. near ref. 80') since it is free to move and roll within the space. This means that there must be some room between the ball and the walls surrounding it that allows it to roll, and there would be some room for motion in a direction at least partially parallel to the longitudinal axis of the shaft.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY CUMBERLEDGE whose telephone number is (571)272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733